

REMARKS

Paragraph 1 of the Office Action

Claim 8 is rejected under under 35 USC §112 second paragraph as being
5 indefinite for failing to particularly point out and distinctly claim the subject matter
which applicant regards as the invention.

Claim 8 has been cancelled.

Withdrawal of the rejection is respectfully requested by the applicant.

10 Paragraphs 2-5 of the Office Action

Claims 1-3, 6-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over
U.S. Patent Number 4,874,025 to Cleveland in view of U.S. Patent Number 2,716,044 to
Overhy.

Claim 1 has been amended to include the limitations of as filed claims 2, 6, 7 and
15 8. In particular, amended claim 1 now includes guides that have edges aligned with the
front of the table. This allows for more flexibility in the positioning of a miter saw and
will accommodate variously sized miter saws. Additionally, amended claim 1 now
includes the limitation of the articulated arm that folds in front of the table. This
positioning is much easier to manipulate because a person can reach these arms from the
20 front of the table.

Cleveland does not show guides positioned adjacent to the front of a table but
instead shows them set back away from the front edge of the table. This places
limitations on the placement and the size of the miter saw that could be used by
Cleveland. In particular, sliding compound saws need more space for operation and
25 should not be set back too far from a front edge of the wall as that would lead a person to
excessively lean forward over the table in order to reach the saw.

Cleveland and Overhy are both silent with respect articulating arms for supporting
the guides and which are positioned in front of the table when the guides are in a stored
position. Both references show supports, but both are located lateral of the object (table
30 or wall) from which their wings are supported. This positioning is harder to manipulate
because it cannot be accomplished from the front of the table without excessive bending,

kneeling, or movement from one side to the other. Applicant's arms can both be reached from the front of applicant's device and thus are easier and more quickly set up.

Additionally, when the guides are in the stored position, the arms prevent the doors from being opened since they are in front of the table. By locking the arms together with a chain or cable, the interior of the table becomes inaccessible.

The Examiner has cited Overby for the break as claimed by applicant. The Examiner states that Overby is a closely related art and therefore it would be obvious to look to Overby when making a combination that includes the elements of applicant's device. It is respectfully offered, however, that the Examiner has mistaken that which could be done with what would be done. To begin, one must look at how applicant's device functions in relation to its structure. Applicant's device includes guides that have breaks therein for selectively increasing their length. The guides, in the stored position, still include the first sections that extend outwardly from the supports. These first sections still function as guides when relatively small portions of material are to be cut.

The second sections increase the length of the guides for larger materials to be cut. Conversely, Cleveland has wings which are either up or down and which do not have a break therein. The Cleveland wings therefore are not analogous to applicant's guides. The Examiner therefore includes Overby to find the break and, subsequently, the supposed limitations of applicant's claims. Overby is a table that includes a break therein so that it can be folded down against a wall while providing space between the table braces and the wall. Cleveland would not want this break in the wings for two reasons.

First, hinges are already attached the wings to the Cleveland table. To add a break would then mean that each of the Cleveland's wings would have two sets of hinges therein. This must be the case as the Examiner cannot simply pick and choose which elements should be included and which should be disregarded. Such a use of the prior art would be prima facie evidence of hindsight reconstruction. Thus, Cleveland would need two sets of supports as well. A first set for the first section of the wings attached to the table and a second set for supporting the two portions of the wings now hingedly coupled together. This construction would be inefficient, would form an instable work surface and therefore is not obvious.

Second, the wings of Cleveland each contain "a slidable insert wing extension 16 which may be longitudinally extended from wing 12." Column 3, lines 63-64. A break in the wings would cease the functionality of the inserts as the break would extend through those inserts. Also, the break in applicant's device creates first and second sections which are used to increase the length. Cleveland does not need the first and second portions of Overly because Cleveland already has the inserts for increasing the length of the wings. If Cleveland has no use for a structure having a break therein to increase the length of the wings, how can such a modification be found to be obvious?

Based on these findings, there could be no motivation to combine the two devices as the combination would destroy the structure and functionality of the Cleveland device as taught by Cleveland. As this is the case, there can be no any motivation found within the Cleveland and Overby devices to make the combination. That the Examiner has found the combination to be obvious in light of the divergent teachings is evidence of hindsight reconstruction. This is an improper method of forming an obviousness argument.

Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (PTO Bd. App. 1985).

Since the combination cannot be obvious for the reasons stated above, and because the elements of arms positionable in front of the table are not found within the prior art, it is believed that claim 1, claim 11 and all claims ultimately depending from claim 1, are in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraph 6 of the Office Action

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cleveland
5 in view of Overby as applied to claim 1 above, and further in view of U.S. Patent
4,483,573 to Keller.

Applicant concedes that Keller discloses doors, but, based on the statements
above, it is believed that claim 4 is now in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraphs 7-8 of the Office Action

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cleveland
in view of Overby as applied to claim 1 above, and further in view of U.S. Patent Number
3,261,307 to Salkoff.

15 Salkoff has been cited for showing wheels. Applicant respectfully disagrees with
the Examiner that a serving table is analogous to a worktable. Wheels on serving tables
are notorious, but they are not notorious for worktables as there may be some danger of
injury associated with an unsteady saw. Applicant notes that neither Cleveland, Keller,
nor Overby disclose wheels. It cannot be said wheels were unknown at the time of their
20 filings. That they chose not to include wheels is evidence that wheels on worktables are
in fact nonobvious.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraph 9 of the Office Action

25 Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over
Cleveland in view of Overby as applied to claim 1 above, and further in view of Keller
and Salkoff.

For the reasons stated above, it is believed that claim 11 is in condition for
allowance.

30 The applicant respectfully requests withdrawal of the rejection.

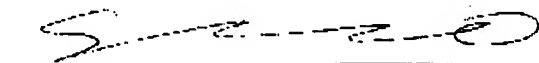
CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: 5/12/05

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